



Docket No.: SON-3031
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Fumio Shimizu et al.

Application No.: 10/560,358

Confirmation No.: 8888

Filed: December 12, 2005

Art Unit: 2178

For: EDITING DEVICE AND METHOD

Examiner: K. R. Stork

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed April 15, 2009.

All arguments presented within the Appeal Brief of January 6, 2009, are incorporated herein by reference. Additional arguments are provided herein.

I. STATUS OF CLAIMS

III.A. Current Status of Claims

A complete listing of the claims with corresponding status is provided as follows:

Claim 1. (Rejected).

Claim 2. (Cancelled).

Claim 3. (Cancelled).

Claim 4. (Rejected).

Claim 5. (Cancelled).

Claim 6. (Cancelled).

Claim 7. (Rejected).

Claim 8. (Rejected).

III.B. Claims On Appeal

Appellant hereby appeals the final rejection of claims 1, 4, 7, and 8.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration in this appeal, with separate arguments as noted in the following sections, are as follows:

Whether the Examiner erred in rejecting claims 1 and 4 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. No. 2003/0206203 to Ly.

Whether the Examiner erred in rejecting claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2003/0206203 to Ly in view of U.S. Pub. No. 2003/0219226 to Newell et al.

These issues are discussed in the following section.

III. ARGUMENT

III.A. Introduction

In the Final Office Action of June 6, 2008, the Examiner erred in rejecting claims 1 and 4 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. No. 2003/0206203 to Ly (“Ly”); and the Examiner erred in rejecting claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2003/0206203 to Ly (“Ly”) in view of U.S. Pub. No. 2003/0219226 to Newell et al. (“Newell”).

Consistent with the grouping of claims in the following section, these rejections are variously deficient as noted in the separate arguments.

III.B. The Examiner erred in rejecting claims 1 and 4 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. No. 2003/0206203 to Ly (“Ly”).

Ly discloses a method of collaborating unstructured data using multiple concurrent collaboration displays. (Ly, para. [0010].) “Each collaboration display may use a selectable set of categories to display the data object.” (Ly, para. [0010].) “In this way, each collaboration display may be configured to view the data object with a desired level of structure.” (Ly, para. [0010].) Ly asserts that, “[b]y selecting and focusing on particular categories, each user may view the same data in a manner that is most effective for that particular user.” (Ly, para. [0011].) Accordingly, multiple concurrent users may use and arrange data in a way that “keeps the structure from impeding creativity.” (Ly, para. [0011].)

Ly suggests editing based on user actions, disclosing that a user may interact with the data in a “freeform and creative way,” using “a graphical interaction device, such as a mouse, or other pointing device to arrange, add, and delete notes to facilitate a creative thought process.” (Ly, para. [0037].) Ly further discloses that the electronic process is constructed to “advantageously” use graphical interactions, “such as dragging and dropping functions, for facilitating ease of use and efficient interactions.” (Ly, para. [0037].)

Ly also discloses that “[m]ultiple distributed clients are allowed to view and modify the same collaborative document in near real time as changes or additions are made by other users.” (Ly, para. [0088].) Users are enabled to make live updates, and “those changes may be reflected in the displays of other users, with only a systematic delay.” (Ly, para. [0088].)

In Ly, data arrangements have several data objects. (Ly, para. [0085], FIG. 22.) The data objects of the data arrangement 322, 324 are stored in data arrangement files 329, 331. (Ly, para. [0085].) Different collaborating data arrangements display different sets of data objects. (Ly, para. [0086].) However, certain data objects may be “imported” from one data arrangement to another. (Ly, para. [0086]; see also data object 341 imported from data arrangement 322 into data arrangement 324 in Ly FIG. 22.) “The importation [is] accomplished via a communication between” the data arrangement files 329, 331 of the collaborating data arrangements 322, 324. (Ly, para. [0086].) Once the importation from data arrangement 322 to data arrangement 324 is complete, the imported data arrangement is shown as 341a. (Ly, para. [0086].)

Once the data object is imported, the imported data object may be either linked or unlinked to the original data object. (Ly, para. [0086].) If linked, then, if the user of an original data arrangement 322 makes changes to a original data object 341, the system may be configured to automatically update data object 341a, to seek approval from the user of the importing data arrangement 329 before updating the change to the corresponding imported data object 341a, or not update the data object 341a at all. (Ly, para. [0086].)

Ly discloses that the collaboration framework “allow[s] clients to share their modifications, in near real time, with other clients.” (Ly, para. [0089].) When a user modifies the document, that collaborative edit is “substantially immediately” routed to all other interested parties via a collaboration server. (Ly, para. [0089].) Network traffic is minimized by propagating only the changes to collaborating clients, instead of the entire data set. (Ly, para. [0089].) “[C]hanges are propagated as proposed changes that are presented to users for acceptance.” (Ly, para. [0089].) “Using such proposed changes allows inputs from all users to be accommodated, but reduces errors from simultaneous changes and possible inconsistent displays.” (Ly, para. [0089].)

Ly does disclose that users may have varying levels of access and security, higher level users being able to make changes directly and lower level users needing their additions or modifications approved by an approval process. (Ly, paras. [0084].) Then, “[o]nce accepted and approved,... the added or modified data objects may be presented to [a] display file and presented to all active data arrangements.” (Ly, para. [0084].) In another instance, Ly discloses that “changes are propagated as proposed changes that are presented to users for acceptance.” (Ly, para. [0089].) Ly asserts that such a method “reduces errors from simultaneous changes and possible inconsistent displays.” (Ly, para. [0089].)

Distinct from Ly, Applicant’s invention relates to an editing device and method which reduces the waiting time of editing data and is suitably applied to an on-air system used in a television broadcasting station. (Substitute Spec., pg. 1, lines 6-8; pg. 2, lines 12-14.)

Applicant’s claim 1 recites: *[a]n editing device for executing an editing process based on a list specifying edit details and registering an obtained editing result in an external device, comprising:*

processing means for performing a prescribed process on edit material;

registration means for registering the editing result in the external device; and

control means for controlling said processing means and said registration means, wherein

said control means controls said processing means so as to perform the process on only necessary parts out of the edit material and controls said registration means so as to register only a result of the process of the necessary parts in the external device as the editing result, wherein

said control means controls said processing means so as to perform the process on only necessary parts out of the edit material based on the list and controls said registration means so as to register only a result of the process of the necessary parts as the editing result in the external device when the list being created is reproduced according to external operation in a creation mode of the list, wherein

when a batch registration mode is set, and a registration request of the editing result based on the list entered by external operation is given after the list is finished, said control means controls said processing means so as to perform the process on only necessary parts of which a result of the process has not been registered in the external device, out of the necessary parts out of the edit material, and controls said registration means so as to register a result of the process of the necessary parts in the external device as the editing result, and wherein

when a sequential registration mode is set, and a sequential part registration request is received when the list is being created, said control means controls said processing means so as to perform the process and control said registration means so as to register a sequential result of the process on only necessary parts that have not been registered in the external device.

Ly fails to disclose or suggest many of the features recited in claim 1. For instance, while Ly suggests editing based on a user interacting with the data in a “freeform and creative way,” using “a graphical interaction device, such as a mouse, or other pointing device to arrange, add, and delete notes to facilitate a creative thought process,” claim 1 recites “[a]n editing device for executing an editing process based on a list specifying edit details[.]”

In the Examiner’s Answer, the Examiner admits that this recitation “has not been given patentable weight because the recitation occurs in the preamble.” (Examiner’s Answer, p. 6, ll. 19-21.) However, the Examiner is in error. The Federal Circuit has taught that “[i]f... the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). However, “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the

claim.” *Pitney*, 182 F.3d at 1305, 51 USPQ2d at 1165-66 (Fed. Cir. 1999) (quoting *Kropa v. Robie*, 38 CCPA 858, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951)).

In claim 1, the preamble recites “*an editing process based on a list specifying edit details*[.]” The body of the claim makes numerous references to the list, but it is the preamble that states what the list specifies, namely “*edit details*.” Accordingly, because the feature “*an editing process based on a list specifying edit details*” recited in the preamble “is ‘necessary to give life, meaning, and vitality’ to the claim,” it should be considered by the Examiner as if in the balance of the claim.

Further, in the Examiner’s Answer, the Examiner asserts that “Ly discloses obtaining a change list.” (Examiner’s Answer, p. 7, ll. 11-16.) To anticipate a claim, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Ly discloses that “in a specific implementation, changes are propagated as proposed changes that are presented to users for acceptance. However, Ly makes no mention whatsoever of “*an editing process based on a list specifying edit details*.”

The Examiner’s Answer further opines that because “Ly discloses that the propagation changes happen in near simultaneous fashion, with each edit pushed to clients from a server,” and that “[m]ultiple edits performed within a single document would push multiple items, constituting a list of changes from the server to recipient clients.” (Examiner’s Answer, p. 7, l. 17 – p. 8, l. 2.) The Appellant disagrees and asserts that edits made to data in a “freeform and creative way” (Ly, para. [0037]), and which are “substantially immediately” (Ly, para. [0089] routed to other collaborative users in “near real time” (Ly, para. [0089]) cannot be considered “*an editing process based on a list specifying edit details*,” as recited in claim 1.

In the Examiner’s Answer, the Examiner contends that Ly discloses batch registration modes, with the batch registration mode registering the editing result after the list specifying edit details is finished. (Examiner’s Answer, p. 8, ll. 3-16.) However, while Ly does disclose “in a specific implementation, changes [being] propagated as proposed changes that are presented to users for acceptance” (Ly, para. [0089]), Ly fails to disclose or suggest batch registration modes,

with the batch registration mode registering the editing result after the list specifying edit details is finished.

Specifically, Ly fails to disclose or suggest “[a]n editing device... wherein when a batch registration mode is set, and a registration request of the editing result based on the list entered by external operation is given after the list is finished, [a] control means controls [a] processing means so as to perform the process on only necessary parts of which a result of the process has not been registered in [an] external device, out of the necessary parts out of the edit material, and controls [a] registration means so as to register a result of the process of the necessary parts in the external device as the editing result[.]”

Ly suggests only manual operations on data, disclosing that a user may interact with the data in a “freeform and creative way,” using “a graphical interaction device, such as a mouse, or other pointing device to arrange, add, and delete notes to facilitate a creative thought process.” (Ly, para. [0037].) Further implying manual operations on data, Ly discloses that the electronic process is constructed to “advantageously” use graphical interactions, “such as dragging and dropping functions, for facilitating ease of use and efficient interactions.” (Ly, para. [0037].)

In response to the arguments in Applicant’s April 28, 2008 Amendment, the Office Action alleges that “an option allows for approval of updates. In this instance, the batch of updates are held, and do not occur until a reviewer approves the updates.” (Office Action, pg. 6, lines 19-21.) Apparently alleging that the “option allow[ing] for approval of updates” constitutes setting a batch registration mode, with the batch registration mode registering the editing result after the list specifying edit details is finished, the Office Action seems to highlight significant differences between the present invention and the disclosure of Ly.

Ly discloses that “if the user of data arrangement 322 makes a change to data object 341, the system could be configured to automatically update data object 341a, or to seek approval from the user of data arrangement 329 before making an update to data objection 341a, or not update data object 341a at all.” (Ly, para. [0086].)

It should be noted that whether or not the change made by the user of data arrangement 322 to data object 341 is updated in the corresponding data object 341a in data arrangement 324, the change to data object 341 is made regardless of whether the user of data arrangement 329 allows data object 341a to be updated or not. In other words, Ly does not disclose that the actual editing to data object 341 is performed by batch processing, but merely that after changes are made to data object 341, the updating of corresponding data object 341a may be postponed by another collaborative user.

Further, in the Examiner's Answer, the Examiner contends that "even if the user has specified that data objects should be automatically updated (Ly, para. [0086]), the serial nature of the updates remains a batch process, as each update is performed prior to performing any subsequent update." However, in so stating, the Examiner appears to confound what he had previously referred to in Ly as "a sequential registration mode" where "the updates are pushed to users once received." (Examiner's Answer, p. 4, l. 20 – p. 5, l. 3.)

Claim 1 recites two registration modes, batch registration and sequential registration. "When a batch registration mode is set, and a registration request of the editing result based on the list entered by external operation is given after the list is finished, said control means controls said processing means so as to perform the process on only necessary parts of which a result of the process has not been registered in the external device, out of the necessary parts out of the edit material, and controls said registration means so as to register a result of the process of the necessary parts in the external device as the editing result[.]"

"[W]hen a sequential registration mode is set, and a sequential part registration request is received when the list is being created, said control means controls said processing means so as to perform the process and control said registration means so as to register a sequential result of the process on only necessary parts that have not been registered in the external device.

Although Ly discloses "a specific implementation [where] changes are propagated as proposed changes that are presented to users for acceptance," Ly fails to disclose the identical

invention shown in as complete detail as is contained in claim 1. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Because Ly fails to disclose or suggest each and every limitation of claim 1, and because Ly fails to disclose the identical invention shown in as complete details as contained in claim 1, Appellant respectfully requests reversal of the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by Ly.

For reasons similar to those provided regarding claim 1, Ly fails to teach, disclose, or suggest each and every limitation of claim 4. Accordingly, Appellant respectfully requests reversal of the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by Ly.

III.C. The Examiner erred in rejecting claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2003/0206203 to Ly ("Ly") in view of U.S. Pub. No. 2003/0219226 to Newell et al. ("Newell").

Claims 7 and 8 depend from claims 1 and 4, respectively, and thus incorporate the features recited therein. For the reasons stated above, Ly fails to teach, disclose, or suggest many of the features incorporated into claims 7 and 8, and Newell does not remedy the deficiencies of Ly.

Newell discloses "a method and system for accessing video data stored on a hard disk storage device." (Newell, para. [0009].) Newell's disclosure involves a processor "used to generate a preview sequence comprising video sequences extracted from each video program in the storage device." (Newell, para. [0009].) "The preview sequence may be provided as a grid containing a plurality of video sequences and other textual or graphical data related to the programs displayed, or may be provided as a sequence of video sequences." (Newell, para. [0009].) Further, Newell discloses that "[t]he processor also generates a graphical use interface to allow a user to select a video program from video sequences that are displayed." (Newell, para. [0010].) Then, "[o]nce selected, the program corresponding to the video sequence may be viewed, deleted, or edited." (Newell, para. [0010].)

The Newell reference is apparently relied upon for its disclosure wherein the sequential part registration is prompted by a selection of a preview command; however, the reference offers no disclosure or suggestion of the features described above as being absent from Ly.

Because the relied-upon references, even in combination, still fail to yield Applicant's claimed invention, a prima facie case of obviousness has not been presented regarding claims 7 or 8. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Accordingly, Appellant respectfully requests reversal of the Examiner's rejection of claims 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over Ly in view of Newell.

IV. CONCLUSION

For the reasons stated above, Appellant submits that the final rejection of claims 1, 4, 7, and 8 was improper and should not be sustained. Reversal of the Examiner's decision is respectfully requested.

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Respectfully submitted,

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